

Rejection Under 35 U.S.C. § 101

In the Office Action, claims 13 - 15 were rejected under 35 U.S.C. § 101 because the claimed invention was deemed to be directed to non-statutory subject matter. Applicant traverses. Claims 13 - 15 were amended for clarification purposes. The amendments are non-narrowing. Applicant requests reconsideration and allowance of claims 13 - 15.

Rejection Under 35 U.S.C. § 112

In the Office Action, claims 9 and 20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses. Claims 9 and 20 are believed to meet the statutory requirements of § 112, second paragraph. Applicant requests reconsideration and allowance of claims 9 and 20.

Rejections Under 35 U.S.C. § 102

In the Office Action, claims 10, 16, 18 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by KenKnight et al. (U.S. Patent No. 6,317,615).

Concerning claim 10:

Claim 10 has been amended. Applicant respectfully traverses the rejection as applied to amended claim 10. The Office action fails to make out a proper *prima facie* case of anticipation under 35 U.S.C. § 102(e) because applicant can not find where in the portions of KenKnight specifically cited in the Office Action where KenKnight teaches every element of claim 10 as amended. Specifically, applicant is unable to find in the cited portions of KenKnight an implantable electrical field generating device connected to the heart rhythm sensing unit, as recited in part in amended claim 10. Applicant requests reconsideration and allowance of claim 10.

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AMENDMENT AND RESPONSE

Serial Number: 09/852,919

Filing Date: May 10, 2001

Title: METHOD AND DEVICE FOR PREVENTING PLAQUE FORMATION IN CORONARY ARTERIES

Page 7

Dkt: 279.330US1

Concerning claims 16, 18 and 20:

Applicant respectfully traverses the rejection. Claims 16, 18, and 20 are dependent on claim 10. Claims in dependent form shall be construed as to include all of the limitations of the claim incorporated by reference into the dependent claim (*See* 37 CFR 1.75(c)). Applicant submits that claims 16, 18 and 20 are allowable for the reasons stated previously for amended claim 10.

Applicant requests reconsideration and allowance of claims 10, 16, 18, 20.

Rejections Under 35 U.S.C. § 103

In the Office Action, claims 1 - 3 and 6 - 8 were rejected under 35 U.S.C. § 103(a) being unpatentable over Chekanov (U.S. Patent No. 6,201,991) in view of Dev et al. (U.S. Patent No. 6,347,247).

Concerning claim 1:

Claim 1 has been amended. Applicant respectfully traverses the rejection applied to amended claim 1. The Office action fails to make out a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a) because the proposed combination of Chekanov and Dev fails to describe all of the elements of claim 1 of the present application as amended. For example, Applicant is unable to find wherein generating the electrical field includes outputting a non-excitatory electrical field such that the electrical field does not interfere with the heart rhythm, as recited in amended claim 1.

Further, the proposed combination of Chekanov and Dev teach away from the present application because the cited portions of the proposed combination describe providing an electric impulse to stimulate muscle contraction (*see* Chekanov col.3 lines 42 - 49).

Applicant respectfully requests allowance of amended claim 1.

Concerning claim 2, 3 and 6 - 8:

Claims 2, 3 and 6 - 8 are ultimately dependent on claim 1. Claims in dependent form shall be construed as to include all of the limitations of the claim incorporated by reference into

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the dependent claim. Thus, Applicant submits that claims 2, 3 and 6 - 8 are allowable for the reasons stated previously for claim 1.

Also, the proposed combination of Chekanov and Dev fails to describe all of the elements of claim 2. Applicant is unable to find in the proposed combination wherein the lead includes an electrode patch, and providing the lead includes positioning the electrode patch epicardially on a heart adjacent to the coronary artery, as recited in claim 2. Applicant submits that the plate described in Dev does not read on the patch in claim 2 because the plate in Dev would not allow an epicardial placement of the electrode.

Further, the proposed combination fails to describe all of the elements in claim 3. Applicant is unable to find in the proposed combination wherein providing the lead includes inserting the lead into a vein adjacent the coronary artery, as recited in part in claim 3. Chekanov describes a placement in the muscle or connective tissue (see col. 3 lines 42 - 49) adjacent the vessel to be cleared. Dev describes a site exo-luminal or endo-luminal to the vessel to be cleared (see col. 6 lines 28 - 35). Thus, the proposed combination of Chekanov and Dev does not describe an endo-luminal placement exterior that is to the vessel to be cleared. Moreover, the proposed combination of Chekanov and Dev does not suggest the success of such a placement.

Furthermore, the proposed combination fails to describe all of the elements of claim 7. Applicant is unable to find connecting the implant to at least two electrodes on a lead such that the electrical field is generated between the at least two electrodes, as recited in claim 7. In contrast, the cited portions of the proposed combination describe electrodes on different leads.

Applicant requests reconsideration and allowance of claims 2, 3, and 6 - 8.

In the Office Action, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chekanov (U.S. Patent No. 6,201,991) in view of Dev et al. (U.S. Patent No. 6,347,247) and further in view of KenKnight et al. (U.S. Patent No. 6,317,615) as related to claim 1.

Applicant respectfully traverses the rejection. The Office Action fails to make out *prima facie* obviousness because there is no motivation to make the proposed combination of Chekanov and Dev with KenKnight. Chekanov describes providing electric impulses to stimulate muscle

contraction (see col. 3 lines 42 - 49), while KenKnight describes delivering the electrical energy during contractions (predetermined portions of QRS complexes - see col. 6 lines 52 - 55) to avoid interference with heart rhythms. Thus, the two documents strive to achieve incompatible results.

Also, claims 4 and 5 are ultimately dependent on claim 1. Claims in dependent form shall be construed as to include all of the limitations of the claim incorporated by reference into the dependent claim. Thus, Applicant submits that claims 4 and 5 are allowable for the reasons stated previously for claim 1.

In the Office Action, claims 11, 14 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over KenKnight et al. (U.S. Patent No. 6,317,615) in view of Chekanov (U.S. Patent No. 6,201,991).

Applicant respectfully traverses the rejection. As discussed previously, the Office Action fails to make out *prima facie* obviousness because there is no motivation to make the proposed combination of Chekanov with KenKnight.

Also, claims 11, 14 and 19 are dependent on claim 10. Claims in dependent form shall be construed as to include all of the limitations of the claim incorporated by reference into the dependent claim. Thus, Applicant submits that claims 11, 14 and 19 are allowable for the reasons stated previously for amended claim 10.

Further, even if the proposed combination is made, the combination fails to describe all of the elements of claim 19. Applicant is unable to find in the cited portions of the documents wherein the electrical field generating device includes a controller and therapy circuits for providing heart rhythm management signals to a heart.

Applicant requests reconsideration and allowance of claims 11, 14 and 19.

In the Office Action, claims 12, 13 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over KenKnight et al. (U.S. Patent No. 6,317,615) in view of Dev et al. (U.S. Patent No. 6,347,247).

Applicant respectfully traverses the rejection. Claims 12, 13 and 17 are dependent on

claim 10. Claims in dependent form shall be construed as to include all of the limitations of the claim incorporated by reference into the dependent claim. Thus, Applicant submits that claims 12, 13 and 17 are allowable for the reasons stated previously for amended claim 10.

Allowable Subject Matter

In the Office Action, claim 9 was indicated to be allowable if rewritten to overcome the rejection(s) under 35 USC § 112, second paragraph, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims. Also, claim 15 was indicated to be allowable if rewritten to overcome the rejection(s) under 35 USC § 112, second paragraph, and the rejection under 35 U.S.C. § 101, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims. Claims 9 and 15 are rewritten into independent form and are believed to be allowable.

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Page 11

Dkt: 279.330US1

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-349-9587) to facilitate prosecution of this application.

Applicant has enclosed a check in the amount of \$342.00 to cover the fee for adding additional claims. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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By



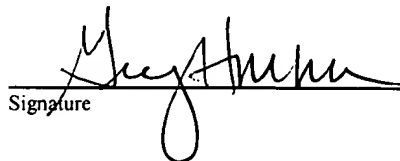
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 23 day of January, 2003.

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